

Appl. No. 10/632,279  
Atty. Docket No. AA539MC  
Amdt. dated October 22, 2004  
Reply to Office Action of April 22, 2004  
Customer No. 27752

### **REMARKS**

Claims 1-23 are pending in the present application. Claim 1 has been amended to further define the present invention wherein the matter of Claim 3 and Claim 8 have been incorporated into the claims. Claim 3 and Claim 8 have been canceled.

In particular, Claim 1 has been further defined wherein the inorganic heat generating agent is an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof and wherein the polyoxyalkylene derivative is a polyoxyethylene/polyoxypropylene block copolymer.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

### **Double Patenting Rejection**

Claims 1-19 and 23 have been provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over Claims 1-18 of copending Application No. 10/273,816 as well as over Claims 1-20 of copending Application No. 10/632,375. In setting forth this rejection, the Examiner indicated that a timely filed Terminal Disclaimer over these common owned applications would overcome the rejection.

Responsive to this rejection, a Terminal Disclosure under 37 C.F.R. 1.321(c) for the above-entitled application which specifies that the Petitioner disclaims the terminal part of the statutory term of any patent granted on the above entitled application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending Application Numbers 10/273,816 and 10/632,375. Submission of the Terminal Disclaimer thus obviates the provisional obviousness-type double patenting.

### **Art Rejections**

#### **1) & 2) Double Patenting Rejection**

Claims 1-19 and 23 have been provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over Claims 1-18 of copending Application No. 10/273,816 as well as over Claims 1-20 of copending Application No. 10/632,375. In setting forth this rejection, the Examiner indicated that a timely filed Terminal Disclaimer over these common owned applications would overcome the rejection.

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Responsive to this rejection, a Terminal Disclosure under 37 C.F.R. 1.321(c) for the above-entitled application which specifies that the Petitioner disclaims the terminal part of the statutory term of any patent granted on the above entitled application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending Application Numbers 10/273,816 and 10/632,375. Submission of the Terminal Disclaimer thus obviates the provisional obviousness-type double patenting.

**3) 35 U.S.C. § 102(b) as being anticipated by EP 897719 (EP 719)**

Claims 1, 2, 6, 9-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by EP 897719 (EP 719). Applicants respectfully traverse this rejection.

EP 719 is discloses topical compositions comprising a solid heat generating material that generates heat upon mixing with water, an anionic surfactant and an anhydrous carrier or diluent. EP 719 discloses the use of inorganic particles such as zeolite as a heat generating material. However, EP 719 does not disclose or teach the specific inorganic salts of the present invention, as found in original Claim 3. and now incorporated into Claim 1 of the present invention. Namely, EP 719 does not teach an inorganic heat generating agent as an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof.

Further, EP 719 does not disclose or teach wherein the polyoxyalkylene derivative is a polyoxyethylene/polyoxypropylene block copolymer, as found in original Claim 8, and now incorporated into Claim 1 of the present invention.

Therefore, the present invention is not anticipated by EP 719 and Applicants request reconsideration and withdraw of the rejection.

**4) 35 U.S.C. § 102(e) as being anticipated by US 2002/0051798 to Koike et al ('798)**

Claims 1-4 and 9-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by US 2002/0051798 to Koike et al ('798). Applicants respectfully traverse this rejection.

'798 discloses a gommage cosmetic composition comprising a water soluble polymer and a substance that is liquid at 25°C (excluding water). Further '798 discloses that the cosmetic composition may comprise a component which generates heat upon contact with water for the purpose of giving users a warmed feeling in addition to the effect of the gommage. Examples of

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such a component include various inorganic salts such as magnesium sulfate, calcium chloride and magnesium chloride.

However, '798 does not disclose or teach wherein the polyoxyalkylene derivative is a polyoxyethylene/polyoxypropylene block copolymer, as found in original Claim 8, and now incorporated into Claim 1 of the present invention.

Therefore, the present invention is not anticipated by '798 and Applicants request reconsideration and withdraw of the rejection.

5) 35 U.S.C. § 102(e) as being anticipated by US application 10/273,816 (PGPUB no. 2003/01082502)

Claims 1-23 are rejected under 35 U.S.C. § 102(e) as being anticipated by US application 10/273,816 (2003/01082502). Applicants respectfully traverse this rejection.

The Examiner has asserted that the applied reference has common inventors with the instant application. Based upon the earlier effective filing date of the reference, the Examiner has asserted that US application 10/273,816 constitutes prior art under 35 U.S.C. § 102(e).

Applicants respectfully direct the Examiner's attention to the effective filing dates and claimed priorities of the instant application and the applied reference. The instant application is a continuation application and properly claims priority to PCT/US01/20651 filed 06/27/2001 and also claims priority to the parent application PCT/US01/03422 filed 02/01/2001. However, the applied reference, US application 10/273,816 has an effective filing date of 10/30/2001, which is later than the effective filing date of the instant application. Therefore, Applicants do not believe that the 102(e) rejection is proper and request reconsideration and withdraw of this rejection.

Further, the Examiner has asserted that Claims 1-23 of the instant application are directed to the same invention as that of Claims 1-18 of commonly assigned 10/273,816. The Examiner has further asserted that the issue of priority under 35 U.S.C 102(g) and possibly 102(f) of this single invention should be resolved. Applicants would like to point out that the claims of the present application have been amended to further define the instant invention and are not directed to the same invention as that of Claims 1-8 of commonly assigned 10/273,816. In particular, the instant invention, as now amended, requires the inorganic heat generating agent is an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof. This is not a required element of the co-pending application claims. Therefore, in view of the instant invention, as now amended, Claims 1-23 of the instant invention are not directed

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toward the same invention as Claims 1-18 of commonly assigned 10/273,816 (PGPUB No. 2004/0028711). As discussed above, the instant application is a continuation application and properly claims priority to PCT/US01/20651 filed 06/27/2001 and also claims priority to the parent application PCT/US01/03422 filed 02/01/2001. The applied reference, US application 10/273,816 has an effective filing date of 10/30/2001.

6) The Examiner has asserted that Claims 1-23 are directed toward the same invention as that of Claims 1-20 of commonly owned 10/632,375 (PGPUB No. 2004/0028711). The Examiner has further asserted that the issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved. Applicants would like to point out that the claims of the instant application have been amended to further define the instant invention and are not directed to the same invention as that of Claims 1-20 of commonly assigned 10/632,375. In particular, the instant invention, as now amended, requires the polyoxyalkylene derivative which is a polyoxyethylene/polyoxypropylene block copolymer. This is not a required element of the co-pending application claims. Therefore, in view of the instant invention, as now amended, Claims 1-23 of the instant invention are not directed toward the same invention as Claims 1-20 of commonly owned 10/632,375 (PGPUB No. 2004/0028711).

7) The Examiner has asserted that commonly assigned 10/273,816 and 10/632,375 would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application were made. In order for the Examiner to resolve this matter, the Assignee is required under 35 U.S.C. 103(c) and 37 C.F.R. 178(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter.

Applicants respectfully submit that commonly assigned 10/273,816 and 10/632,375 were commonly owned at the time the invention in this application was made. Applicants provide the recordation of assignments for each of the applications as follows:

Appln. 10/632,279 - Date Recorded 1-23-04 at Reel No. 014281 Frame No. 0902; Appln. 10,273,816 - Date Recorded 12/20/02 at Reel No. 013313 Rframe No. 0013; Appln. 10,632,375 - Date Recorded 8/13/04 at Reel No. 015061 Frame No. 0920.

#### 103 Rejections

8) Claims 5 and 6 and 18-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al ('798) in view of U.S. 6,540,989 to Janchitraonvej ('989). Applicants respectfully traverse this rejection.

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In order to establish a prima facie cast of obviousness, the Examiner must show that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there is a reasonable expectation of success, and (3) all of the limitations of the claims are taught or suggested in the prior art (M.P.E.P. § 2143).

However, all of the limitation of the claims are not taught or suggested in the prior art. Specifically, as the Examiner asserts, '798 discussed in the above paragraphs, fails to specify the claimed micron sizes of the inorganic heat-generating agent, the specific derivatives of Claims 6-8. The Examiner asserts further that '798 fails to teach the composition for hair application and lacks amidoamines of the instant claims. However, as Applicants has stated above, '798 does not disclose or teach wherein the polyoxyalkylene derivative is a polyoxyethylene/polyoxypropylene block copolymer, as found in original Claim 8, and now incorporated into Claim 1 of the present invention, from which Claims 5-6, 18-20 and 23 depend. Likewise, '989 does not teach an inorganic heat generating agent as an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof, nor does '989 teach the specific polyoxyalkylene derivatives. Therefore, all of the limitations of the claims, as now amended, are not taught or suggested in the either '798 or '989. Applicants have shown that there is therefore no prima facie cast of obviousness and respectfully request withdraw of the rejection.

9) Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over '798 by itself or in view of EP 027 730 (EP '730). Applicants respectfully traverse this rejection.

The Examiner asserts that Claims 6-8 recite polyoxyalkylene derivatives, in particular Claims 8 recites polyoxyethylene/polyoxypropylene block copolymer. The Examiner asserts that '798 fails to specifically teach the claimed polyoxyalkylene derivatives of the instant claims. EP '730 teaches cosmetic compositions for hair or skin treatment, comprising heat generating compounds when brought into contact with water. Among the heat generating compounds EP '730 teaches fatty alcohols, alkylene glycols and polyoxyalkylene derivatives. Therefore, the Examiner asserts that it would have been obvious for one of skill in the art to use pluronic or any other suitable polyoxyalkylene derivatives as heat generating agents in the composition of '798 because EP '730 teaches that the above polyoxyalkylene derivatives are preferable as heat generating compounds and suggest that the heat generating compound give an excellent finishing and cleansing effect to consumer upon application, which results in a comfortable hot feeling.

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However, the Examiner has not provided the requisite motivation to combine or modify '798 with '730 so as to obtain Applicants invention. The present invention, as now amended, requires the use of an inorganic heat generating agent as an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof. In the present invention, it is believed that polyalkylene derivatives can help the dispersion of inorganic heat generating agents and thus prevent the agglomeration of inorganic heat generating agents which causes gritty feel to the skin and/ or hair.

However, neither '798 or '730 recognize the problem (gritty feel due to agglomeration) caused by the use of inorganic salt, nor recognize the need to reduce gritty feel. '798 teaches the use of components such as magnesium chloride, calcium chloride and magnesium sulfate as a component that generates heat upon contact. However, there is no teaching in '798 recognizing the problem of gritty feel due to agglomeration of inorganic heat generating agents and therefore does not seek a component to solve such a problem i.e. polyoxyethylene/polyoxypropylene block copolymers. Therefore, one of skill in the art would not be motivated to combine '798 with another reference, in order to provide a solution to this problem. '730 teaches that polyoxyalkylene derivatives act as heat generating compounds. There is no teaching in '730 that polyalkylene derivatives can help the dispersion of inorganic heat generating agents and thus prevent the agglomeration of inorganic heat generating agents which causes gritty feel to the skin and/ or hair. There is no motivation to combine '798, which teaches components such as magnesium chloride, calcium chloride and magnesium sulfate as a component that generates heat upon contact, and combine with '730 which teaches another type of heat generating component, namely polyalkylene derivatives. And even if '730 was combined with '798, there is no motivation to select the specific block copolymers, as now required by the present invention, among a variety of other heat generating compounds i.e. fatty alcohols, alkylene glycols, in order to use it with the specific heat generating inorganic salts of the present invention. Applicants have shown that there is therefore no prima facie cast of obviousness and respectfully request withdraw of the rejection.

- 10) Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over '798 in view of US 6,540,989 ('989) as applied to claims 5, 6, 17-20 and 23 above and further in view of EP 027,730 (EP '730). Applicants respectfully traverse this rejection.

The Examiner asserts that it would have been obvious to one of skill in the art to use the pluronic or any other suitable polyoxyalkylene derivatives as heat generating agents in the

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composition of '798 because '730 teaches that the polyoxyalkylene derivatives are preferable as heating compounds and are give an excellent finishing effect, which results in a comfortable hot feeling.

As stated above, all of the limitation of the claims are not taught or suggested in the prior art. Specifically, as Applicants has stated above, '798 does not disclose or teach wherein the polyoxyalkylene derivative is a polyoxyethylene/polyoxypropylene block copolymer, as found in original Claim 8, and now incorporated into Claim 1 of the present invention, from which Claims 5-6, 18-20 and 23 depend. Likewise, '989 does not teach an inorganic heat generating agent as an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof. Nor does '989 teach the specific polyoxyalkylene derivative. Therefore, all of the limitations of the claims, as now amended, are not taught or suggested in the either '798 or '989.

However, the Examiner has not provided the requisite motivation to combine or modify '798 with '730 so as to obtain Applicants invention. The present invention, as now amended, requires the use of an inorganic heat generating agent as an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof. In the present invention, it is believed that polyoxyalkylene derivatives can help the dispersion of inorganic heat generating agents and thus prevent the agglomeration of inorganic heat generating agents which causes gritty feel to the skin and/ or hair.

However, neither '798 nor '730 recognize the problem (gritty feel due to agglomeration) caused by the use of inorganic salt, nor recognize the need to reduce gritty feel. '798 teaches the use of components such as magnesium chloride, calcium chloride and magnesium sulfate as a component that generates heat upon contact. However, there is no teaching in '798 recognizing the problem of gritty feel due to agglomeration of inorganic heat generating agents and therefore does not seek a component to solve such a problem. i.e. polyoxyethylene/polyoxypropylene block copolymers. Therefore, one of skill in the art would not be motivated to combine '798 with another reference, in order to provide a solution to this problem. '730 teaches that polyoxyalkylene derivatives act as heat generating compounds. There is no teaching in '730 that polyalkylene derivatives can help the dispersion of inorganic heat generating agents and thus prevent the agglomeration of inorganic heat generating agents which causes gritty feel to the skin and/ or hair. There is no motivation to combine '798, which teaches components such as magnesium chloride, calcium chloride and magnesium sulfate as a component that generates heat upon contact, and combine with '730 which teaches another type of heat generating component,

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namely polyalkylene derivatives. And even if '730 was combined with '798, there is no motivation to select the specific block copolymers, as now required by the present invention, among a variety of other heat generating compounds i.e. fatty alcohols, alkylene glycols, in order to use it with the specific heat generating inorganic salts of the present invention. Applicants have shown that there is therefore no prima facie cast of obviousness and respectfully request withdraw of the rejection.

#### Conclusion

Applicants have made an earnest effort to place their application in proper form and distinguish their claimed invention from the prior art which was applied in the April 22, 2004 Office Action. WHEREFORE, consideration of this application, consideration of the accompanying claims and claim amendments submitted herewith, withdrawal of the rejections under 35 U.S.C § 102 and 35 U.S.C § 103, and allowance of Claims 1-23 are respectfully requested.

Respectfully submitted,  
Mikio Uchida et al.

By Linda M. Sivik  
Linda M. Sivik  
Agent for Applicants  
Registration No. 44,982  
Tel. No. (513) 626-4122

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